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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD R. RHOADS and JAMES P. KETRENOS

Appeal 2008-2317
Application 10/764,617¹
Technology Center 2100

Decided: November 20, 2008

Before JOSEPH L. DIXON, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 15 and 26 through 30. Claims 16 through 25 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on January 26, 2004. The real party in interest is Intel Corp.

The Invention

Appellants invented a method and system for organizing information stored in a non-volatile reprogrammable semiconductor memory. (Spec. 1.) As depicted in Figure 5, the memory is segmented into a plurality of partitions. (Spec., 11, ll. 4-25.) Each partition of the non-volatile reprogrammable memory has a defined address (22), which is stored in another partition of that same memory device. (*Id.* 15, ll. 1-15.)

Representative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method of organizing stored information on a non-volatile, reprogrammable semiconductor memory comprising:

partitioning said memory into a plurality of partitions, each having a defined address; and

storing the defined address for one partition in another partition.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Bunnell	US 5,594,903	Jan. 14, 1997
Tallam	US 6,948,099 B1	Sep. 20, 2005
		(filed Jul. 30, 1999)

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

A. Claims 1 through 15 and 26 through 30 stand rejected under non-statutory obviousness-type double patenting over claims 1 through 8 Tallam.

B. Claims 1 through 15 and 26 through 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tallam.

C. Claims 1 through 15 and 26 through 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bunnell.

Appellants' Contentions

1. Appellants argue that Tallam's claims do not teach storing a defined address for one partition in another partition, as recited in independent claim 1. (App. Br. 10-11, Reply Br. 1-2.) Therefore, Appellants submit that Tallam's claims cannot be properly relied upon to reject the claimed invention under non-statutory obviousness-type double patenting. (*Id.*)

2. Appellants argue that while Tallam's Specification discloses the limitation of storing the defined address of one partition into another partition, such limitation was neither invented nor claimed by Tallam. (*Id.*) As detailed in the declaration submitted by Appellants' representative under 37 C.F.R. § 1.132, Appellants contend that they invented the claimed limitation prior to the filing date of the Tallam application for patent. (*Id.*)

Further, they assert that during the drafting of the Tallam application, the cited material was derived from inventors Rhoads and Ketrenos. (*Id.*) Therefore, Appellants submit that the disclosure of the Tallam patent cannot be properly relied upon to reject the claimed invention under anticipation.

3. Appellants argue that Bunnell does not teach a non-volatile reprogrammable semiconductor memory wherein the defined address of one partition is stored in another partition, as recited in independent claim 1. (Appeal Br. 12-13, Reply Br. 3-4.) Therefore, Appellants submit that Bunnell does not anticipate the claimed invention. (*Id.*)

Examiner's Findings

1. The Examiner finds that, as recited in claim 2 of the Tallam patent, the second portion for storing a recovery operating system and instructions to obtain an outside operating system substantially teaches the claimed limitation recited in Appellants' claim 10. (Ans. 11-12.) The Examiner therefore concludes that Tallam's claims render Appellants' claims unpatentable under non-statutory obviousness double patenting. (*Id.*)

2. The Examiner finds that the declaration submitted by Appellants' representative to be insufficient to show that Appellants invented the claimed limitation prior to the filing date of the Tallam application for patent. (*Id.* 12-13.) Therefore, the Examiner maintains that Tallam anticipates the claimed invention. (*Id.*)

3. The Examiner finds that Bunnell's disclosure of a virtual memory having a nonvolatile portion implemented as an EPROM or EEPROM that uses headers to provide address of a data segment to a corresponding code segment in an alterable portion of the memory teaches the claimed limitations. (*Id.* 14-15.) Therefore, the Examiner maintains that Bunnell anticipates the claimed invention. (*Id.*)

II. ISSUES

1. Have Appellants shown that the Examiner erred in concluding that the second portion for storing a recovery operating system and instructions, as recited in claim 2 of the Tallam patent, renders Appellants' claimed invention unpatentable under non-statutory obviousness double patenting? We answer this inquiry in the affirmative.

2. Have Appellants shown that the Examiner erred in finding that Tallam's disclosure of storing the address of a partition in another partition antedates Appellants' claimed invention? We answer this inquiry in the negative.

3. Have Appellants shown that the Examiner erred in finding that Bunnell's disclosure of a memory space having a ROM and a RAM wherein the ROM uses headers to access address information and copy data in the RAM teaches the claimed invention? We answer this inquiry in the affirmative.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Appellants' Admission

Appellants confirm the following:

1. Appellants' representative, Mr. Timothy Trop, drafted both the Application on appeal and that of the Tallam patent. (App. Br.10.)
2. As a matter of convenience, Mr. Trop utilized in the two applications for patent a common Specification combining the two separate inventions. (*Id.*)
3. Mr. Trop filed a declaration under 37 C.F.R. § 1.1.32 to show that the claimed material pertaining to storing the defined address for one partition into another partition is attributed to Appellants pursuant to MPEP 716.10. Particularly, the declaration indicates that, while the cited subject matter is disclosed in the Specification of the Tallam patent, it was neither invented nor claimed by Tallam. Rather, it was invented and claimed by Rhoads and Ketrenos of the present application. (*Id.*)

Tallam

4. As depicted in Figure 5, Tallam discloses a memory partitioned into a plurality of segments, each having a defined address (22). (Col. 4, ll. 59-67.)

5. As shown in Figure 7, Tallam discloses storing the defined address for one partition in another partition. (Col. 6, ll. 24-38.)

6. Tallam's claims recite a FLASH memory having a plurality of partitions, wherein a first partition stores a primary operating system, and wherein a second partition stores a recovery operating system and instructions to obtain a new operating system outside of the memory. (Col. 8, ll. 9-48.)

Bunnell

7. As depicted in Figure 3, Bunnell discloses a main memory (14) having a virtual address space portion (60) including a non-volatile ROM segment (62), which is implemented using a combination of ROM, EPROM, EEPROM and flash EPROM storage devices. The virtual storage device (60) further includes an alterable portion of memory (64) implemented as a RAM. (Col. 7, ll. 41-52.)

8. For each application program to be executed, Bunnell discloses storing in the ROM a plurality of address headers and data segments associated with the program. Bunnell also discloses storing in the RAM code segments (116, 118, 120, 122) corresponding to the data segments for the program. To execute the application program, the headers provide the address of the corresponding code segments to the data segments (Col. 10, l. 35- col. 1. 24.)

PRINCIPLES OF LAW

35 U.S.C. § 101

Double Patenting

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also any modifications or variants thereof which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

In re Zickendraht, 319 F.2d 225, 232 (CCPA 1963) (Rich, J., concurring).

Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. *In re Van Ornum*, 686 F.2d 937 (CCPA 1982).

ANTICIPATION

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a

finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

DERIVATION

When the unclaimed subject matter of a patent, application publication, or other publication is applicant’s own invention, a rejection, which is not a statutory bar, on that patent or publication may be removed by *submission of evidence* establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based. *In re Mathews*, 408 F.2d 1393 (CCPA 1969); *In re Facius*, 408 F.2d 1396 (CCPA 1969). See MPEP 715.01(c)

ATTRIBUTION

When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference

available as prior art under 35 U.S.C. § 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 C.F.R. § 1.131 showing prior invention (see MPEP § 715) or *an unequivocal declaration* by S under 37 C.F.R. § 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application... However, it is incumbent upon *the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. § 102(f) or to rebut a rejection under 35 U.S.C. § 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 C.F.R. § 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. In re Katz*, 687 F.2d 450, 455 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide “a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor” of the subject matter disclosed in the article and claimed in the application). See MPEP § 716.10.

ANALYSIS

35 U.S.C. § 101

As set forth in the Findings of Fact section, Tallam’s claims recite a reprogrammable semiconductor memory having a plurality of partitions for

storing different operating systems. (FF. 6.) We fail to find any teaching in the cited claims pertaining to storing the address of one partition in another partition. We agree with Appellants that the Examiner improperly relied upon non-claimed subject matter disclosed in the detailed description of the Tallam patent, as evidence of the state of the prior art. We therefore, conclude that one of ordinary skill in the art would not have combined subject matter disclosed in the detailed description and the claim of the cited patent to render the claimed invention unpatentable under obviousness-type double patenting. It follows that Appellants have shown that the Examiner erred in concluding that Tallam renders the claimed invention unpatentable under obviousness-type double patenting. We therefore, will not sustain the Examiner's rejection of claims 1 through 15 and 26 through 30 as being unpatentable under obviousness-type double patenting.

35 U.S.C. § 102

1. *Tallam*

As set forth in the Findings of Facts, Appellants' representative submits a declaration under 37 C.F.R. § 1.132 to show that the subject matter pertaining to storing the address of a partition in another partition of a non-volatile reprogrammable memory was invented by Appellants, and not Tallam. (FF. 1-3.) We agree with the Examiner that the submitted declaration is insufficient to show that the claimed subject matter is either attributed to or derived from Appellants. Firstly, the declaration is improper

to show that the claimed subject matter is attributed to Appellants since they did not jointly file the present application with Tallam's. Therefore, attribution is not germane to this case. Secondly, the declaration is insufficient to show that the invention was derived from Appellants since it fails to prove that Appellants invented the claimed subject matter. Particularly, the submitted declaration merely provides a conclusory statement by Appellants' representative to suggest that the cited subject matter was invented by Appellants and not Tallam. We note however that such gratuitous statement, without any supporting evidence to show the actual descriptions or statements of the inventions that the representative received from each of the respective inventive entities before combining the inventions into one, is not persuasive. While the declarations and the exhibits are in the form of testimonial and corroborating evidence, arguments of counsel are not evidence. See, e.g., *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). It follows that Appellants have not shown that the Examiner erred in finding that Tallam anticipates independent claim 1. Therefore, we will sustain the rejection of independent claim 1.

Appellants did not provide separate arguments with respect to the rejection of claims 1 through 15 and 26 through 30. Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, claims 2 through 15 and 26 through 30 fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

2. *Bunnell*

As set forth in the Findings of Fact section, Bunnell discloses a virtual memory space having a non-volatile reprogrammable ROM and an erasable RAM. Particularly, Bunnell discloses using headers to communicate addresses of data segments in the ROM with corresponding code segments in the RAM during the execution of an application program. (FF. 7-8.)

While Bunnell teaches that the ROM is a non-volatile and reprogrammable memory (i.e., implemented through EEPROM) having headers to copy data into a RAM during execution of the program, it does not teach that storing the address of one partition of the non-volatile/reprogrammable memory into another partition of said memory. Rather, it teaches storing data (not address) from a segment of the non-volatile programmable ROM to another segment of the erasable RAM. We thus agree with Appellants that Bunnell does not reasonably teach the claimed limitation. It follows that Appellants have shown that the Examiner erred in finding that Bunnell anticipates claim 1. Because claims 2 through 15 and 26 through 30 recites these same limitations, we will not sustain the Examiner's rejection of claims 1 through 15 and 26 through 30 as being anticipated by Bunnell.

CONCLUSIONS OF LAW

- A. Appellants have shown that the Examiner erred in finding that:
1. Tallam renders claims 1 through 15 and 26 through 30 unpatentable under non-statutory obviousness-type double patenting.

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2. Bunnell anticipates claims 1 through 15 and 26 through 30 under 35 U.S.C. § 102(b).

We reverse these rejections

B. Appellants have not shown that the Examiner erred in finding that Tallam anticipates claims 1 through 15 and 26 through 30 under 35 U.S.C. § 102(e). We affirm this rejection.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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